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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,131	01/31/2001	Michel Marcel Jose Decre	PHNL000078	5393

24737 7590 03/30/2005

PHILIPS INTELLECTUAL PROPERTY & STANDARDS  
P.O. BOX 3001  
BRIARCLIFF MANOR, NY 10510

EXAMINER
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MARKHAM, WESLEY D

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/773,131

Applicant(s)

DECRE, MICHEL MARCEL JOSE

Examiner

Wesley D Markham

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**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 08 March 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) a set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ They raise the issue of new matter (see NOTE below);
- (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached Advisory action. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_.
- Claim(s) objected to: \_\_\_\_\_.
- Claim(s) rejected: 1-8 and 15-19.
- Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_
13. ☐ Other: \_\_\_\_\_.

TIMOTHY MEEKS  
PRIMARY EXAMINER

WDM

**ADVISORY ACTION**

***Response to Amendment***

1. Acknowledgement is made of the after-final amendment filed by the applicant on 3/8/2005, in which the applicant proposed to amend Claims 18 and 19. However, this amendment has not been entered because it raises new issues that would require further searching and/or consideration by the examiner, and it raises the issue of "new matter" in the claims (i.e., lack of written description under 35 U.S.C. 112, first paragraph). Specifically, the proposed amendment to Claims 18 and 19 would require that the number of parts used to form the polygonal shape be equal to half of the sides within the polygonal shape (proposed Claim 18), and each of the parts to be congruent (proposed Claim 19). These proposed claims are of significantly different scope than the presently pending claims, which require that the number of sides of the at least two sides used to form the polygonal shape be equal to half of the sides within the polygonal shape (Claim 18), and that each of the sides be congruent (Claim 19). As such, the proposed amendment would require further consideration on the part of the examiner. Additionally, it appears that entry of the proposed amendment to Claims 18 and 19 would raise a 35 U.S.C. 112, first paragraph, issue with regards to the limitation that the number of parts used to form the polygonal shape be equal to half of the sides within the polygonal shape. After reviewing the originally filed specification, the examiner finds no support, either explicit, implicit, or inherent, for the aforementioned limitation. The applicant shows a singular example (see Figure 2C) in which the number of parts used to form the

shape (i.e., 3 parts) is equal to half of the total number of sides of the polygon (i.e., 6 sides). However, the disclosure of a single example (i.e., a single species) does not provide support for the broad, potentially infinite, genus of structures in which the number of parts is equal to half the number of sides of the polygonal shape, as the applicant proposes to claim. Please note that the written description requirement for a claimed genus may be satisfied by sufficient description of a "representative number of species", which means that the species that are adequately described must be representative of the entire genus. Satisfactory disclosure of a "representative number" depends on whether one of skill in the art would recognize that the applicant was in possession of the necessary common attributes or features of the elements possessed by the members of the genus in view of the species disclosed (MPEP 2163(II)). In this case, a single figure which happens to show a six-sided polygonal extension body having three parts is not a "representative number" of species sufficient to convey to one skilled in the art that the applicant had possession of the broad genus of structures in which the number of parts is equal to half the number of sides of the polygonal shape, which the applicant now proposes to claim.

### ***Response to Arguments***

2. Applicant's arguments filed on 3/8/2005 have been fully considered but they are not persuasive.

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3. First, the applicant argues that the proposed amendments to Claims 18 and 19 were made to improve the form of the claims, no change to the scope of the claims was intended, and the use of the word "sides" is an obvious slip of the pen. In response, this argument is not convincing. As set forth above in paragraph 1, the scope of Claims 18 and 19 would be changed if the proposed amendment was entered. Regarding the "obvious slip of the pen" argument, the examiner notes that only some and not all of the occurrences of the word "sides" in Claims 18 and 19 were proposed to be changed to "parts". Prior to the proposed amendment, how was the examiner to know which "sides" actually meant "parts" and which "sides" actually meant "sides" in the context of the claims? The proposed amendment does more than simply correct a readily apparent error, as the applicant implies.
4. Second and regarding the 35 U.S.C. 112, first paragraph, rejection, the applicant argues that one is allowed to phrase his claims broadly to cover other embodiments, unless the examiner can find art that would render such claims invalid. In response, this argument is not convincing. The test under 35 U.S.C. 112, first paragraph, is whether the claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. After reviewing the originally filed specification, the examiner finds no support, either explicit, implicit, or inherent, for the limitations proposed in Claims 18 and 19. The applicant shows a singular example (see Figure 2C) in which the number of parts used to form the shape (i.e., 3 parts) is equal to half of the total

number of sides of the polygon (i.e., 6 sides). However, the disclosure of a single example (i.e., a single species) does not provide support for the broad, potentially infinite, genus of structures in which the number of parts is equal to half the number of sides of the polygonal shape, as the applicant proposes to claim. Please note that the written description requirement for a claimed genus may be satisfied by sufficient description of a “representative number of species”, which means that the species that are adequately described must be representative of the entire genus.

Satisfactory disclosure of a “representative number” depends on whether one of skill in the art would recognize that the applicant was in possession of the necessary common attributes or features of the elements possessed by the members of the genus in view of the species disclosed (MPEP 2163(II)). In this case, a single figure which happens to show a six-sided polygonal extension body having three parts, in the absence of any supporting description regarding the relationship between the number of parts and sides of the polygonal extension body, is not a “representative number” of species sufficient to convey to one skilled in the art that the applicant had possession of the broad genus of structures in which the number of parts is equal to half the number of sides of the polygonal shape, which the applicant now proposes to claim.

5. Regarding the art rejections, the applicant argues that Nishida relates to optical media while Konishi relates to semiconductor manufacturing, and one of ordinary skill in the art would not look to the semiconductor arts to solve problems associated with manufacturing optical disks. In response, both Nishida and Konishi are drawn to

spin coating a substrate with an apparatus and in a manner sufficient to insure that a uniform coating / film is formed on the surface of the substrate. One of ordinary skill in the art would have reasonably expected the problems and solutions associated with obtaining a uniform coating / film on the surface of a substrate by spin coating to be similar, regardless of whether the substrate being spin coated is a semiconductor wafer or an optical disk. In such a situation, one of ordinary skill in the art would have been motivated to look to the spin coating art in general to solve the problems associated therewith; as such, the combination of the Nishida and Konishi references is proper.

6. The applicant also argues that the liquid used in Konishi is a developing solution (not a coating solution), and there is no teaching or suggestion that the parts 32a and 32b of Konishi could be used for the purposes to which the applicant's extension body is put. In response, the process liquid of Konishi is not limited to a developing solution – Konishi explicitly teaches that the process liquid can be a resist solution (Col.9, lines 64 – 67), which is a liquid used to coat the substrate (Col.1, lines 9 – 10). Further, one of ordinary skill in the art would have had a reasonable expectation of success in utilizing a multi-part extension body (as taught by Konishi and claimed by the applicant) as opposed to a single part extension body (as taught by Nishida) in the process of Nishida because both types of extension bodies are removable and would be reasonably expected to achieve similar results (i.e., collecting undesired coating material that is spun-off the edge of the substrate so that, when the body is

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removed, a uniform layer remains on the substrate), regardless of whether the body comprises a single piece or multiple pieces.

7. To conclude, the applicant cites the last paragraph on page 8 of the specification to show “unexpected results” due to the shape of the extension body. In response, this argument is not convincing. First, the results shown by the applicant only compare a circular extension body to a square extension body and thus are not commensurate in scope with the applicant’s claims, which are generally drawn to a polygonal body. Additionally, the fact that the square extension body (Figure 2B) functions more effectively than the circular extension body (Figure 2A) is not unexpected because the overall area of the square extension body is much greater, thereby providing more area for the undesired coating material (i.e., the “hump”) to collect. This result would be expected by one of ordinary skill in the art.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wesley D Markham whose telephone number is (571) 272-1422. The examiner can normally be reached on Monday - Friday, 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Tim Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



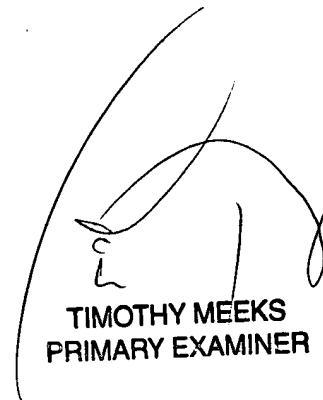
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WDM

Wesley D Markham  
Examiner  
Art Unit 1762



TIMOTHY MEEKS  
PRIMARY EXAMINER